

JUDGE WOODS

16 CV 5426

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

ROBERT G. LOPEZ, an individual,

Plaintiff,

v.

OOSHIRTS, INC.

Defendant.

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Civil Action No.

JURY TRIAL DEMANDED

FILED
U.S. DISTRICT COURT
2016 JUL -7 PM 4:44
S.D. OF N.Y.

**COMPLAINT FOR TRADEMARK INFRINGEMENT,
UNFAIR COMPETITION AND RELATED CLAIMS**

Plaintiff, Robert G. Lopez, alleges his complaint against Defendant, Ooshirts, Inc., as follows:

NATURE OF THE ACTION

1. This action arises from Defendant's infringement of Plaintiff's "ownership" and "use" rights in the marks LES NYC®, LOWER EAST SIDE™ and THE LOWER™, in conjunction with clothing and related goods. Despite Plaintiff being the registered owner of the trademarks LES NYC®, LOWER EAST SIDE™ and THE LOWER™ and offering various clothing items under such brand names, the Defendant has infringed Plaintiff's rights in the aforementioned marks by advertising, promoting, selling, and offering for sale clothing items under Plaintiff's trademarks. Plaintiff has already experienced "actual confusion" in connection with this matter and is likely to continue to experience confusion as to the affiliation or connection between the Defendant and Plaintiff resulting in the unjust enrichment of Defendant by using Plaintiff's registered trademarks.

JURISDICTION AND VENUE

2. This Court has jurisdiction over this action pursuant to 15 U.S.C. §1051 *et seq.*, 15 U.S.C. Sections 1114-1116; under Section 43(a) of the Trademark Act, 15 U.S.C. §1125(a) and Section 43(c) of the Trademark Act, 15 U.S.C. §1125(c).

3. This Court has personal jurisdiction over the Defendant because Defendant engages in continuous and significant business activities in, and directed to the State of New York within this judicial district and ships clothing items into New York County and because Defendant has committed tortuous acts aimed at and causing harm within the State of New York and this judicial district.

4. Venue is proper in this judicial district pursuant to 28 U.S.C. §§ 1391(b) and (c) because it is where Plaintiff resides and the Defendant transacts business, and because a substantial portion of the events giving rise to the asserted claims have occurred, and continue to occur, within this district. Furthermore, the damage to Plaintiff and its intellectual property described herein continues to occur in this judicial district.

THE PARTIES

5. Plaintiff, Robert G. Lopez is an individual residing at 230 Clinton Street, Apt. #11C, New York, NY 10002.

6. Upon information and belief, Defendant Ooshirts, Inc. is a California corporation with a principal place of business at 41454 Christy Street, Fremont, California 94538. Defendant may be served through its registered agent, Raymond Lei, at 10035 Byrne Avenue, Cupertino, California 95014.

FACTS

7. Since at least as early as 1999, Plaintiff Robert G. Lopez has been selling headwear, t-shirts, sweaters, hooded sweatshirts and other clothing items under the LES NYC®, LOWER EAST SIDE™ and THE LOWER™ brand names.

8. Since at least as early as 1999, Plaintiff has been independently operating a clothing business under the trade name L.E.S. CLOTHING CO.™, which has sold headwear, t-shirts, sweaters, hooded sweatshirts and other related clothing items under the marks LOWER EAST SIDE™, LES NYC® and THE LOWER™. Since at least as early as 2010, Plaintiff has also been selling clothing items under the mark LOYALTY EQUALS STRENGTH™ that is an additional representation for the acronym LEST™.

9. In addition to selling and offering for sale clothing items under the LOWER EAST SIDE™, LES NYC®, THE LOWER™, LES CLOTHING CO.™, LEST™ and LOYALTY EQUALS STRENGTH™ brand names, Plaintiff has also continuously sold and offered for sale various clothing items including hooded sweatshirts which bear the LOWER EAST SIDE™, LES NYC® and THE LOWER™ marks in various font and design styles which are prominently displayed on the front and/or back of the headwear, t-shirts and/or sweaters.

10. Plaintiff sells, and promotes the sale of his clothing via his website www.lesclothing.com, through order forms, and his t-shirts and sweaters are also available for sale in several retail locations in New York and other States.

11. Plaintiff advertises his LES CLOTHING CO.™, LOWER EAST SIDE™ and LES NYC® and THE LOWER™ brands and clothing items through flyers, posters, stickers and through grass root street marketing methods such as painted “street murals.” Plaintiff also regularly conducts photo shoots of customers who purchase his LOWER EAST SIDE™, THE LOWER™ and LES NYC® clothing items to be included in magazine advertisements and marketing materials.

12. Plaintiff is the registered owner of United States Trademark Registration No. 4,549,880 for the mark LES NYC®. (See **Exhibit A**).

13. Plaintiff is the registered owner of New York State Trademark Registration No. R31067 for the mark LOWER EAST SIDE™. Plaintiff is also the registered owner of New York State Trademark Registration No. R31773 for the mark THE LOWER. Plaintiff is also the registered owner of several copyrights for LOWER EAST SIDE™ and LES™ related designs and artwork. (See **Exhibit B**).

14. Plaintiff is informed and believes and thereon alleges that Defendant is advertising, marketing, promoting, selling and offering for sale several t-shirts including the ones depicted in the images below under the LOWER EAST SIDE™, LES NYC®, and THE LOWER™ marks and is also promoting the t-shirts in its url <https://teechip.com/nycles1>. The NYCLES1 portion of the aforementioned URL used by Defendant to promote and offer the product for sale is a transposition of Plaintiff's LES NYC® registration thereby heightening additional instances of actual confusion of the source of the products under that trademark. (See **Exhibit C**).



15. Plaintiff was contacted by several long-standing customer of his LES CLOTHING CO™ LOWER EAST SIDE™, THE LOWER™ and LES NYC® clothing products and was asked if the released t-shirt design with the LOWER EAST SIDE™ brand that was sold at Defendants website and they wanted to inquire to purchase the t-shirt designs directly from me..

16. Defendants use of Plaintiff's LOWER EAST SIDE™, THE LOWER™ and LES NYC® brands in connection with clothing has already caused and will continue to cause confusion as to the source or affiliation of the source of the clothing related goods bearing the aforementioned trademarks.

17. Defendants similar designs as those offered by Plaintiff also has the capability of causing additional confusion where Defendants will benefit from all the years of hard work that Plaintiff has expended in building his family of LES™ marks including the brands LOWER EAST SIDE™, THE LOWER™ and LES NYC®.

FIRST CAUSE OF ACTION
TRADEMARK INFRINGEMENT (15 U.S.C. §§ 1114-1116)

18. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 17 of this Complaint.

19. The use in commerce by Defendant of an identical and slightly identical version of Plaintiff's registered trademark is likely to cause confusion, mistake and deception among members of the public and in trade as to the source, origin, or sponsorship of defendants' goods and services. Such use by defendant constitutes a clear and direct infringement of Plaintiff's rights in and to Plaintiff's registered trademark, and has resulted in injury and damage to Plaintiff that will continue if defendant is not ordered to cease all use of the LES NYC® mark.

SECOND CAUSE OF ACTION

UNFAIR COMPETITION & FALSE DESIGNATION OF ORIGIN (15 U.S.C. § 1125(a))

20. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 19 of this Complaint.

21. Plaintiff has the exclusive right to market, brand and provide clothing related goods using the LES NYC® mark.

22. Defendant by reason of the aforementioned acts, have falsely described, represented and designated the origin of its goods and services. Defendants' activities already have confused the public into believing that Defendants and Plaintiff's clothing goods and accessories come from one and the same source, and defendants continued activities are likely to create further confusion and deceive the public concerning the source of the goods/services.

23. Defendant have unfairly profited from the actions alleged herein and will continue to unfairly profit and become unjustly enriched unless and until such conduct is enjoined by this Court.

24. By reason of Defendant's willful acts conducted in conscious disregard for Plaintiff's rights, Plaintiff is entitled to treble damages under 15 U.S.C. § 1117(a).

THIRD CAUSE OF ACTION

COMMON LAW TRADEMARK INFRINGEMENT & UNFAIR COMPETITION

25. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 24 of this Complaint.

26. Defendant's conduct constitutes deception by which Defendant goods will be palmed off as those of Plaintiff. Such conduct constitutes trademark infringement and unfair competition in violation of the laws of the State of New York.

27. Defendant's unauthorized use of Plaintiff's LOWER EAST SIDE™, THE LOWER™, LES NYC® mark is likely to continue to cause further confusion to the public as to the clothing goods and accessories of the respective parties.

28. By reason of the foregoing, Defendant has infringed and continues to infringe on Plaintiff's common law rights in the LOWER EAST SIDE™ and LES NYC® mark and defendant has become unjustly enriched by such acts of infringement.

29. Defendant's unlawful conduct has been and will continue to be willful or willfully blind to Plaintiff's rights, as Defendant has reason to know of Plaintiff's rights.

**FOURTH CAUSE OF ACTION
UNJUST ENRICHMENT**

30. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1 through 29 of this Complaint.

31. Defendant has unjustly retained profits from the sale of clothing goods and accessories bearing Plaintiff's LOWER EAST SIDE™, THE LOWER™ and/or LES NYC® marks.

32. Defendant's actions constitute unjust enrichment.

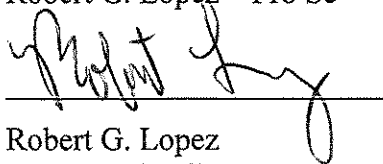
PRAYER FOR RELIEF

WHEREFORE, Plaintiff respectfully prays for relief as follows:

1. Entry of an order and judgment requiring that all defendant, its subsidiaries, officers, agents, servants, employees, owners, and representatives, and all other persons or entities in active concert or participation with them, be preliminarily and, thereafter, permanently enjoined and restrained from (a) using in any manner the trade name, trademark, domain name or other indicia or origin, including in whole or part the term LOWER EAST SIDE™, LES NYC®,

Dated: July 7, 2016
New York, New York

Respectfully submitted,
Robert G. Lopez – Pro Se

A handwritten signature in black ink, appearing to read "Robert G. Lopez", is written over a horizontal line.

Robert G. Lopez
Pro Se Plaintiff
230 Clinton Street – Apt. #11C
New York, New York 10002
(917) 868-1698

EXHIBIT A



United States Patent and Trademark Office

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LES NYC

Word Mark	LES NYC
Goods and Services	IC 025. US 022 039. G & S: Baseball caps and hats; Hooded sweatshirts; Short-sleeved or long-sleeved t-shirts; T-shirts. FIRST USE: 19991200. FIRST USE IN COMMERCE: 19991200
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	85335314
Filing Date	June 1, 2011
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	April 1, 2014
Registration Number	4549880
Registration Date	June 17, 2014
Owner	(REGISTRANT) Lopez, Robert G. INDIVIDUAL UNITED STATES 230 Clinton Street - Apt. #11C New York NEW YORK 10002
Type of Mark	TRADEMARK
Register	PRINCIPAL-2(F)
Live/Dead Indicator	LIVE

EXHIBIT B

New York State Department of State Certificate of Trademark Registration

I Daniel E. Shapiro, Special Deputy Secretary of State, do certify that the Trademark described below and depicted on the attached copy has been duly registered in this Department pursuant to Article 24 of the General Business Law. This registration will remain in force for TEN years from the Date of Registration.

Registration Number: R31067

Registration Date: 06/06/07

Applicant:

ROBERT G. LOPEZ

230 CLINTON STREET APT. #11C

NEW YORK

NY 10002-

**State of Incorporation or
Partnership Organization:**

Class Numbers: 25

Date First Used in NYS: 12/1999

Date First Used Anywhere 12/1999

Trademark Description:

LOWER EAST SIDE

The mark is comprised of the words "Lower East Side" In stylized letters with an underline and overline.

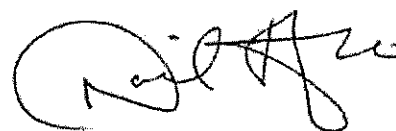
Description of Goods:

Clothing, namely, T-shirts, Hooded Sweatshirts, Vest, Hats and Caps as adopted from the USPTO.

WITNESS *my hand and the seal of the State of New York In
the City of Albany on this:*

Thursday, August 16, 2007

by:



Special Deputy Secretary of State

DOS-690 (Rev. 3/01)



New York State Department of State Certificate of Trademark Registration

I Daniel E. Shapiro, Special Deputy Secretary of State, do certify that the Trademark described below and depicted on the attached copy has been duly registered in this Department pursuant to Article 24 of the General Business Law. This registration will remain in force for TEN years from the Date of Registration.

Registration Number: R31773 **Registration Date:** 11/22/10

Applicant: ROBERT G. LOPEZ
230 CLINTON ST. - APT #11C
NEW YORK NY 10002-

**State of Incorporation or
Partnership Organization:**

Class Numbers: 25

Date First Used in NYS: 03/00/08 **Date First Used Anywhere:** 03/00/08

Trademark Description:

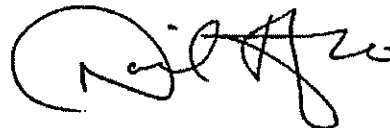
The mark is comprised of the words "THE LOWER" with five stars appearing beneath the literal element of the mark.

Description of Goods: Clothing, namely; T-shirts, hooded sweatshirts and caps.

WITNESS my hand and the seal of the State of New York in
the City of Albany on this:

Monday, November 22, 2010

by:



Special Deputy Secretary of State

EXHIBIT C

Lower East Side Story Men's Tee!!!



f t p
(http://www.facebook.com/teechip)
u=http://teechip.com/nycles1&

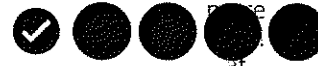
In New York City there are 8 million stories. From eating at Katz's Delicatessen, shopping on Delancey & Orchard Streets, to visiting Chinatown & Little Italy, everyone has a story. Celebrate one of the best places in the world with this awesome tee and let us know... What is your Lower East Side Story?

Available
on
TeeChip

Available Products:

Fruit of the Loom Tee - \$20.00 USD for 22

Colors:



https://teechip.com/nycles1

Buy It Now

This campaign ends in

22	6	57	45
Days	Hours	Minutes	Seconds

Men's The Lower Deck NYC T-Shirt



f t p

(http://www.facebook.com/teechip) (http://twitter.com/teechip) (http://pinterest.com/teechip)

So you're from Downtown NYC. Then you should know that it's also recognized as "The Lower Deck" of New York City. You can't get any further down into Lower Manhattan than this, and this tee will make sure everyone knows that!

Please note: Orders are printed and shipped when the campaign expires (July 23rd). You can expect your package to arrive around 2 - 5 business days after the campaign ends.

Available Products:

Fruit of the Loom Tee - \$20.00 USD

Colors:



Buy It Now

This campaign ends in

22

Days

18

Hours

49

Minutes

34

Seconds